



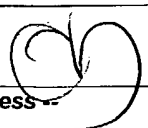
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,145	06/17/2002	Peter Frederick Wilde	690100.402USPC	8205
500	7590	03/09/2004	EXAMINER	
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC			DRODGE, JOSEPH W	
701 FIFTH AVE			ART UNIT	
SUITE 6300			PAPER NUMBER	
SEATTLE, WA 98104-7092			1723	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/049,145	WILDE, PETER FREDERICK	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joseph W. Drodge	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 5-7, 11-14, 19-21, 25, 26, 37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-10, 15-18, 22-24 and 27-36 is/are rejected.
- 7) ☒ Claim(s) 5-7, 11-14, 19-21, 25, 26, 37 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 0402.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

Claims 5-7,11-14,19-21,25,26,37 and 38 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Eggers et al patent 4,675,133.

Eggers et al disclose 1<sup>st</sup> extracting vessel 2, 2<sup>nd</sup> separating vessel 3, substrate holding means 5,7. For claims 16 and 17, see recycling line 19 and means for heating (figure 3 and column 5 generally). For claim 18, see separation zone cooling at column 6, lines 45-47.

Claims 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Franke patent 6,248,910.

Franke discloses first vessel E, second vessel S, means for maintaining/holding oil bearing substrate (column 6, lines 48-54 and 63-66). For claims 16 and 17, see solvent recycling line 22, control valves (column 10, lines 29-30 and column 8, lines 57-59,

etc.). For claim 18, see solvent heating means (column 7, lines 8-14, etc.) and separation vessel cooling means (column 10, lines 13-16).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4, 8-10, 22-24 and 27-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franke patent 6,248,910 in view of Nagasaki et al patent 5,892,136. Franke discloses solvent extraction of oil from oil-bearing substrates with the preferred solvent being any solvent which is normally in a gaseous state, such as compounds related to CHF<sub>3</sub>, CCIF<sub>3</sub> and CBrF<sub>3</sub> and other halogenated hydrocarbons (column 5, lines 6-13 and column 6, lines 16-28) and separation of solvent from oil products in downstream vessel S (column 10, lines 9-47).

The claims all differ in requiring the particular solvent to comprise iodotrifluoromethane. Nagasaki et al teach this chemical as being in normally gaseous state and being generally useful in the manufacturing of agricultural chemicals and

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pharmaceuticals (uses also disclosed by Franke), see column 1, lines 14-27. It would have been obvious to one of ordinary skill in the art to have selected iodotrifluoromethane as the gaseous halogenated hydrocarbon solvent employed, as taught by Nagasaki et al, in the methods disclosed by Franke, in view of the relative greater safety record and reduced environmental problems associated with iodotrifluoromethane, such chemical being expected to have similar solvent properties to the related chemicals disclosed by Franke ( $\text{CHF}_3$ ,  $\text{CCLF}_3$  AND  $\text{CF}_3\text{Br}$ ). Also, see MPEP 2144.09 concerning rejections of claims employing closely related chemical compounds.

Frank also discloses the following:

Regarding claim 2, see first vessel E and flow line 18.

Regarding claim 3, see vessel sealing and pressurizing means at column 6, lines 44-54 and column 7, lines 32-35) and inferred presence of valves at column 8, lines 57-65.

Regarding claims 4, 9 and 24, see heating means at column 9, lines 16-19 and column 17, lines 56-59.

Regarding claims 10 and 23, see separation zone cooling at column 10, lines 14-15.

Regarding claims 29, 32 and 35, see use of additional solvents at column 8, line 65-column 9, line 6.

Regarding claims 31 and 34, see use of co-solvents at column 6, lines 30-35.

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Regarding claims 30,33 and 36, see solvents including fluorinated ethanes at column 6, lines 20-27.


Regarding claim 28, see column 7, lines 30-32, regarding converting recycled solvent into liquid state before introduction to the extracting vessel, hence inferring compression.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Drodge at telephone number 571-272-1140. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at 571-272-1151. The fax phone number for the examining group where this application is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR, and through Private PAIR only for unpublished applications. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD  
March 4, 2004

  
**JOSEPH DRODGE**  
**PRIMARY EXAMINER**